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32173 7590 08/24/2009 DICKSTEIN SHAPIRO LLP 1633 Broadway NEW YORK, NY 10019				
EXAMINER BOYLE, ROBERT C				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

***Attachment to Advisory Action***

1. Applicant's response filed August 12, 2009 has been fully considered but is not persuasive.
2. Applicant argues that there is not disclosure specifically associating a monofunctional vinyl compound, multifunctional acrylic ester and dicarbonyl compound which has two active hydrogens in the methylene position. Applicant's argument is not persuasive. Stark teaches a compositions where the components include glycidyl acrylate (a multifunctional acrylic ester), vinylsilanes (a multifunctional compound with only one vinyl group) and acetoacetoxyethyl acrylate (a dicarbonyl with two "active" hydrogens in the methylene position) (paragraphs 0027, 0031-32).
3. While no examples with this specific combination of compounds were presented in Stark, this combination would have been readily apparent. The rejection over Stark is under 35 USC 103(a), therefore there is no requirement on the reference to disclose the specific combination alluded to for a proper rejection.
4. In paragraph 0027, Stark states "Examples of suitable silicon compounds b) are" and then lists a series of twelve vinyl silanes that satisfy instant claim 1 out of fifteen compounds. With such a group, clearly there is sufficient preponderance of evidence such that one of ordinary skill would have been motivated to use a compound satisfying claim 1.
5. In paragraph 0031, Stark states "Preference is given to glycidyl acrylate, glycidyl methacrylate, allyl glycidyl ether, and vinyl glycidyl ether." Given a list of five molecules for component (c), and where glycidyl acrylate is the first on the list, clearly there is sufficient

preponderance of evidence such that one of ordinary skill would have been motivated to use glycidyl acrylate, satisfying claim 1.

6. In paragraph 0032, Stark recites a list of six molecules for component (d) of which acetoacetoxyethyl acrylate is the first. Again, clearly there is sufficient preponderance of evidence such that one of ordinary skill would have been motivated to use acetoacetoxyethyl acrylate, satisfying claim 1.

7. In light of the above, applicant's argument that a combination of monomers which correspond to claim 1 would be serendipitous is not persuasive. Further, a preferred embodiment is not controlling, rather, all disclosures "including unpreferred embodiments" must be considered. *In re Lamberti* 192 USPQ 278, 280 (CCPA 1976) citing *In re Mills* 176 USPQ 196 (CCPA 1972).

8. Further, any teachings of a "typical," "preferred," or "optimum" species or subgenus within the disclosed genus should be considered. If such a species or subgenus is structurally similar to that claimed, its disclosure may provide a reason for one of ordinary skill in the art to choose the claimed species or subgenus from the genus, based on the reasonable expectation that structurally similar species usually have similar properties. MPEP 2144.08(c); *Dillon*, 919 F.2d at 693, 696, 16 USPQ2d at 1901, 1904. See also *Deuel*, 51 F.3d at 1558, 34 USPQ2d at 1214.

9. Applicant argues that the ranges disclosed by Stark are not limited to the claimed ranges. This is not persuasive. It is well settled that where prior art describes the components of a claimed compound or compositions in concentrations within or overlapping the claimed concentrations a prima facie case of obviousness is established. See MPEP 2144.05; *In re*

*Harris*, 409, F.3d 1339, 1343, 74 USPQ2d 1951, 1953 (Fed. Cir 2005); *In re Peterson*, 315 F.3d 1325, 1329, 65 USPQ 3d 1379, 1382 (Fed. Cir 1997); *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936-37 (CCPA 1990); *In re Malagari*, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA 1974).

10. Applicant argues that Stark is based on free radical polymerization and the instant invention is based on Michael addition chemistry and Moy does not give any reason to substitute a Michael addition for a free radical polymerization. This is not persuasive.

11. It is noted that that claim 6 does not claim the reaction occurs via Michael addition chemistry; and claim 10 recites the process of claim 6 occurs in the presence of a Michael addition catalyst. Neither claim 6 nor claim 10 specify the reaction mechanism. Because of this, the scope of the claims encompasses free radical polymerization in addition to Michael addition reactions.

12. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the Michael addition reaction) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

13. As to Applicant's argument that there is no suggestion or motivation to combine Moy with Stark, it is noted motivation to combine the references to arrive at the claimed invention can be found in the "nature of the problem to be solved" because each reference was directed "to

precisely the same problem of underpinning slumping foundations" and the court also rejected the notion that "an express written motivation to combine must appear in prior art references...." MPEP 2143.01; *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 69 USPQ2d 1686 (Fed. Cir. 2004).

14. In the instant case, it would have been obvious to one of ordinary skill in the art to use the compositions of Moy with the compositions of Stark because both Stark and Moy teach the reaction of multifunctional compounds such as acetate compounds with acrylate compounds for the use in coatings such as paints (Stark: paragraphs 0002-5; Moy, column 1, lines 5-30), and Moy teaches compositions that are not volatile and cannot be readily absorbed through the skin (Moy: abstract; column 1, lines 5-30), and Stark is concerned with low-emission paints (Stark: paragraph 0043). Therefore, Applicant's arguments are not persuasive.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT C. BOYLE whose telephone number is (571)270-7347. The examiner can normally be reached on Monday-Thursday, 9:00AM-5:00PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571)272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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